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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,492	08/16/2001	Thomas J. Colson	IPCP:107_US_	4008
24041	7590	06/06/2005	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/931,492

Applicant(s)

COLSON ET AL.

Examiner

John M Winter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-16, 19-32, 36-38, and 41-44 is/are rejected.
- 7) ☒ Claim(s) 11-13, 17, 18, 33-35, 39 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

Claims 1-44 remain pending.

### *Response to Arguments*

The Applicants arguments filed on September 17, 2004 have been fully considered.

The Applicant states that the cited reference Rivette et al. (767) fails to disclose the claimed feature of "providing a searchable document database and a publication Web site in communication with said document database"

The Examiner responds that as per Figure 3 Rivette discloses a web server that publishes content for web client use, the examiner contends that enabling content on a web page is analogous to publication.

The Applicant states that the cited reference Rivette et al. (751) fails to disclose the claimed feature of "wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product"

The Examiner responds that as per figure 2 Rivette ('751) discloses patent information (element 204), the examiner contends that it is obvious that a patent establishes a bar to the patentability of inventions practiced in said product. (i.e. once an invention is patented other inventors are barred from patenting the same invention)

The Applicant states that the claims of the present invention are directed towards a different purpose and are not obvious in view of the prior art.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of managing intellectual property and therefore would be obvious to a person of ordinary skill in the art.

See following rejection.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-10, 14-16, 19-32, 36-38, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (US Patent 6,339,767) in view of Donner (US Patent 6,154,725) and further in view of Rivette et al. (US Patent 5,991,751).

As per claim 1,

Rivette et al. ('767) discloses a method of publishing a product document, said method comprising the steps of:

providing a searchable document database and a publication Web site in communication with said document database;(Figure 3 [elements 312, 310 content is published for web clients])

Rivette et al. ('767) does not explicitly disclose "electronically receiving said product document transmitted by a client's computer", and publishing said client document by adding said client document to said document database", Donner ('725) discloses "electronically receiving said product document transmitted by a client's computer,(Figure 1) and publishing said client document by adding said client document to said document database".(Figure 2) It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Donner ('725) method in order in order to decrease the latency in document processing by utilizing electronic transmission means.

Rivette et al. ('767) does not explicitly disclose "wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product", Rivette et al ('751) discloses wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product".(Figure 2 [element 204 – discloses patent information] It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Rivette et al. ('767) method with the Rivette et al. ('751) method in order in order to decrease the latency in document processing by utilizing electronic transmission means.

Claim 23 is in parallel with claim 1 and rejected for the same reasons.

As per claim 2,

Rivette et al. ('767) discloses the method of claim 1,  
wherein said product document and one or more attachment files said product document comprises a primary document and one or more attached files.(Figure 2)

Claim 24 is in parallel with claim 2 and rejected for the same reasons.

As per claim 3,

Rivette et al. ('767) discloses the method of claim 1,  
wherein said attachment files include a sample deposition statement.(Column 18, lines 28-30)

Claim 25 is in parallel with claim 3 and rejected for the same reasons.

As per claim 4,

Rivette et al. ('767) discloses the method of claim 2,

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wherein said attachment files include an image of a sales brochure.(Figure 2)

Claim 26 is in parallel with claim 4 and rejected for the same reasons.

As per claim 5,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an image of a purchase order.(Figure 2)

Claim 27 is in parallel with claim 5 and rejected for the same reasons.

As per claim 6,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an image of a sales invoice.(Figure 2)

Claim 28 is in parallel with claim 6 and rejected for the same reasons.

As per claim 7,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an image of a commercial Web site page.(Figure 2)

Claim 29 is in parallel with claim 7 and rejected for the same reasons.

As per claim 8,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an image of a printed advertisement.(Figure 2)  
Claim 30 is in parallel with claim 8 and rejected for the same reasons.

As per claim 9,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include a video clip.(Column 26, lines 9-16; Figure 2)  
Claim 31 is in parallel with claim 9 and rejected for the same reasons.

As per claim 10,  
Rivette et al. ('767) discloses the method of claim 2,  
wherein said attachment files include an audio clip.(Column 26, lines 9-16; Figure 2)

Claim 32 is in parallel with claim 10 and rejected for the same reasons.

As per claim 14,  
Rivette et al. ('767) discloses the method of claim 2,  
Official Notice is taken that "charging said client a fee for adding said product document to said database" is common and well known in prior art in reference to data management. It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to charge a fee for adding a document to the database in order to raise revenue to maintain the upkeep of the database

Claim 36 is in parallel with claim 14 and rejected for the same reasons.

As per claim 15,

Rivette et al. ('767) discloses the method of claim 2,

Official Notice is taken that "fee is paid before said product document is added to said database" is common and well known in prior art in reference to data management. It would have been obvious to one having ordinary skill in the art at the time the invention was made to charge a fee prior to adding a document to the database in order to raise revenue to maintain the upkeep of the database

Claim 37 is in parallel with claim 15 and rejected for the same reasons.

As per claim 16,

Rivette et al. ('767) discloses the method of claim 1,

further comprising the step of recording the number of times said product document is accessed by end users.(Column 36, lines 21-25)

Claim 38 is in parallel with claim 16 and rejected for the same reasons.

As per claim 19,

Rivette et al. ('767) discloses the method of claim 1,

further comprising the step of collecting and adding bibliographic data to said product document.(Column 18, lines 49-66)

Claim 41 is in parallel with claim 19 and rejected for the same reasons.

As per claim 20,

Rivette et al. ('767) discloses the method of claim 1,

wherein said product document is transmitted by said client's computer via one of a plurality of transfer protocols determined by said client.(Column 15, lines 2-3; Figure 3)

Claim 42 is in parallel with claim 20 and rejected for the same reasons.

As per claim 21,

Rivette et al. ('767) discloses the method of claim 20,

wherein said plurality of transfer protocols includes the HTTP and FTP.(Column 15, lines 2-3; Figure 3)

Claim 43 is in parallel with claim 21 and rejected for the same reasons.

As per claim 22,

Rivette et al. ('767) discloses the method of claim 1,

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wherein said product document is published on a restricted basis for access only by users and user groups selected by said client.(Column 36, lines 27-38)

Claim 44 is in parallel with claim 22 and rejected for the same reasons.

***Allowable Subject Matter***

Claims 11-13, 17, 18, 33-35, 39 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is (571) 272-6713. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

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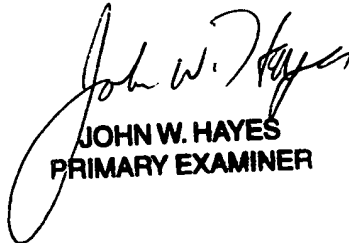
(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50 Dulany St. Alexandria, VA.

JMW

May 29, 2005



JOHN W. HAYES  
PRIMARY EXAMINER